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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,481	09/28/2001	Shuichi Takahashi	1163-0354P	2776

2292 7590 06/04/2003

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

PASS, BARRY

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/964,481

Applicant(s)

TAKAHASHI ET AL.

Examiner

Barry Pass

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The rejection of Claim 8 under 35 U.S.C. 112, second paragraph, has been overcome by the applicant's amendment to the claim.

The objection to Claim 8 is withdrawn.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima JP 012420074A. Nakajima et al. discloses (abstract, Figs. 1-4) a non-invasive method and apparatus for adjusting irradiation conditions by controlling patient position during radiotherapy treatment comprising imaging in three dimensions a diseased part in a patient to be subjected to radiation therapy; an imaging means comprising a plurality of devices; generating images of the target in uncorrected and distortion-corrected forms; relating the position of the target positioning means, the target imaging means and the irradiation means in three dimensions; correcting patient position to compensate for patient movement as it occurs by using a computer-controlled system (inherent to which is an algorithm) for continuously monitoring the positions of the target in three dimensions, and then altering the position of the target to maintain alignment of the patient with a predetermined three-dimensional coordinate system.

Examiner notes that a full translation of Nakajima has not been provided with this action but a detailed description of the system and method of Nakajima is recited in columns 1-2 of Kunieda et al. (prior art cited in the previous action for this application). A translated abstract of Nakajima has been provided.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Alternatively, claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishihara (as cited in the previous action for this application). Nishihara discloses (abstract, Figs. 4, 7, 8 and columns 6, 9, 12, respectively) a method and system for controlling radiation therapy conditions during treatment comprising positioning a marker invasively or non-invasively (column 2, lines 45-62) adjacent to the target of interest on a patient to be subjected to radiation therapy, and imaging the marker and target using a plurality of imaging devices; relating the position of the marker and target positioning means, the marker and target imaging means and the irradiation means in 3 dimensions; irradiating the target according to prescribed conditions; continuously correcting the irradiating conditions to compensate for patient movement as it occurs by using a computer-controlled system (inherent to which is an algorithm) for continuously monitoring the positions of the marker and target in three-dimensions, comparing images taken during treatment with images taken for therapy planning, and then altering the irradiating conditions to maintain the prescribed therapy.

6. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

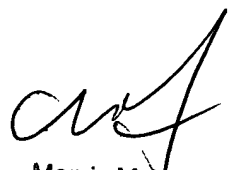
Schweikard et al. US 6,144,875 teach a system and method for correcting irradiating conditions of a patient comprising non-invasively imaging a target of interest in the patient using a plurality of imaging devices; relating the position of the target positioning means, the target imaging means and the irradiation means in 3 dimensions; irradiating the target according to prescribed conditions; correcting the irradiating conditions to compensate for patient movement as it occurs by using a computer-controlled system for monitoring in real-time the positions of the target in three-dimensions, comparing images taken during treatment with images taken for therapy planning, and then altering the irradiating conditions to maintain the prescribed therapy.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Pass whose telephone number is (703) 305-0726. The examiner can normally be reached on Monday-Friday, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (703) 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0758 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.

Barry Pass   
May 18, 2003

  
Marvin M. Lateef  
Supervisory Patent Examiner  
Group 3700